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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 619,261	07 19 2000	Michael Peter Corby	C7520(V)	1305

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UNILEVER
PATENT DEPARTMENT
45 RIVER ROAD
EDGEWATER, NJ 07020

EXAMINER

MCAVOY, ELLEN M

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 07 16 2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/519,261	CORBY ET AL.	
	Examiner	Art Unit	
	Ellen M McAvoy	1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 06 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-943)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-16 are still rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicants' arguments filed 6 May 2002 have been fully considered but they are not persuasive. As set forth in the previous office action, independent claims 1 and 16 are drawn toward a method for lubricating a conveyor belt surface comprising "applying a liquid composition suitable for producing a dry lubricant film on the conveyor belt surface". The examiner maintains the position that the specification is not enabled for any and all liquid compositions suitable for producing a dry lubricant film on a conveyor belt surface. Applicants argue that they are "not claiming any liquid compositions but only those that, for example, produce a dry lubricant on the surface of a conveyor belt surface". The examiner is of the position that applicants do not have enablement in the specification for claiming all such lubricants. Indeed, the specification on page 2 discloses that "we have now surprisingly found that certain specific liquid formulations suitable for producing a 'dry' lubricant film can be advantageously used as a conveyor belt lubricant". The examiner is of the position that these "certain specific liquid formulations" have enablement in the specification and constitute applicants invention. It has been well established that there must be a reasonable correlation

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between the scope of the exclusive right granted to a patent applicant and the scope of enablement set forth in the patent application. *In re Fisher*, 427 F.2d 833, 839; 166 USPQ 18, 24 (CCPA 1970).

Claims 1, 3, 4, 6, 11 and 16 are also still rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is still not clear what is encompassed by the term "aqueous phase" in these claims; whether the term encompasses water only, water and the specific alcohols taught in the specification on page 6 (methanol, ethanol and isopropanol), water and the polyhydric alcohols taught in the specification on page 8 (glycerine (aka glycerol), propylene glycol and ethylene glycol), or water and other additives taught in the examples of the specification. *It is not clear* what exactly applicants regard as their invention.

It is also not clear what is encompassed by "said composition comprising at most 95% by weight of an aqueous phase" in independent claims 1 and 16. This encompasses 0 to 95% by weight of an aqueous phase. It is not clear what comprises the other 5 to 100% of the liquid composition suitable for producing a dry lubricant film on the conveyor belt surface.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moses (5,549,836) in combination with Douty et al (4,149,624).

Moses discloses a substantially mineral oil-free aqueous composition useful to produce a dry lubricant film comprising (a) about 20 to 95% by weight of an aqueous phase; (b) about 0.2 to 6% by weight of an anionic surfactant, nonionic surfactant or a mixture thereof; and (c) the balance comprising a mixture of (i) a silicone oil, vegetable oil, or combination thereof, and a film-forming material selected from alcohols, monocarboxylic acids and primary amides. The composition may further include a finely divided dispersion of polytetrafluoroethylene. See the claims. Moses teaches that the aqueous compositions are useful in a wide variety of lubricating applications including metal working and general lubrication, and that the compositions can be dispersed by spraying. See column 1, lines 10-38. Applicants invention differs by lubricating a conveyor belt surface. Although lubricating conveyor belt surfaces is not taught by Moses, Douty et al ["Douty"] is added to show that aqueous solutions of silicone emulsions are known as lubricants for conveyor belts. The water-based silicone emulsions can be applied in more than one place, i.e., discontinuously, to the conveyor belt surface. See figure 1. Thus, the examiner is of the position that having the prior art references before the inventors at the time the invention was made it would have been obvious to have applied the aqueous compositions useful to produce a dry lubricant film of Moses to a conveyor belt apparatus because Moses teaches that

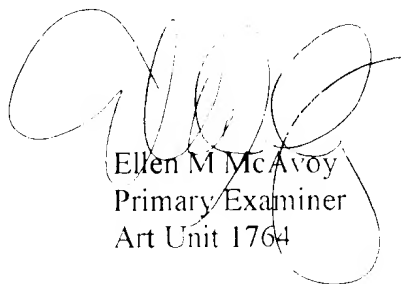
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the compositions are useful in general lubrication and Douthett teaches that such lubricants are suitable for conveyor belt surfaces.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (703) 308-2510. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marian Knodel can be reached on (703) 308-4311. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Ellen M McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
July 11, 2002